



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,467	07/24/2006	Keiji Maruoka	NANP133US	2292
23623	7590	10/19/2009		
TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114				
EXAMINER				
COLEMAN, BRENDA LIBBY				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
10/19/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet1@thepatentattorneys.com
hholmes@thepatentattorneys.com
lpasterchek@thepatentattorneys.com

Office Action Summary

Application No.

10/587,467

Applicant(s)

MARUOKA, KEIJI

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 17-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/4/2006; 10/24/2006; 11/18/2008; & 8/6/2009.

DETAILED ACTION

Claims 1-30 are pending in the application.

Election/Restrictions

1. Applicant's election of Group I in the reply filed on July 1, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 17-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 1, 2009.

Specification

3. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 371, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If

the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference

was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of n where there are two different

definitions for the variable n , i.e. n is 0, 1 or 2 on page 4, line 10 and n is 1 to 12 on page 10, line 13; page 12, line 5; page 13, line 24; page 15, line 16; page 17, line 9; page 19, line 1; page 20, line 20; page 22, line 12; and page 24, line 4.

b. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of m where there are two different definitions for the variable m , i.e. m is 1 or 2 on page 4, line 10 and m is an integer from 2 to 8 on page 24, lines 5-6.

c. Claim 9 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of n where there are two different definitions for the variable n , i.e. n is 0, 1 or 2 on page 33, line 15 and n is 1 to 12 on page 39, line 19; page 41, line 11; page 43, line 3; page 44, line 22; page 46, line 15; page 48, line 7; page 49, line 26; page 51, line 18; and page 53, line 10.

d. Claim 9 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of m where there are two different definitions for the variable m , i.e. m is 1 or 2 on page 33, line 16 and m is an integer from 2 to 8 on page 53, lines 11-12.

e. Claim 13 is vague and indefinite in that it is not known what is meant by the open parenthesis where there is no close parenthesis, i.e. page 56, line 24.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1624

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Kano et al., Tetrahedron Asymmetry. Kano teaches the compounds and the process of preparing the compounds of formula (I) where R^1 , $R^{1'}$, R^2 , $R^{2'}$, R^3 , $R^{3'}$, R^4 , $R^{4'}$, R^5 , $R^{5'}$, R^6 , and $R^{6'}$ are hydrogen, X is Br^- and R^7 and R^8 are each n-butyl as set forth in example (S)-11 on page 1244.

7. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Abbott et al., Analyst. Abbott teaches the compounds and the process of preparing the compounds of formula (I) where R^1 , $R^{1'}$, R^2 , $R^{2'}$, R^3 , $R^{3'}$, R^4 , $R^{4'}$, R^5 , $R^{5'}$, R^6 , and $R^{6'}$ are hydrogen; X is Br^- and R^7 and R^8 are each cyclohexyl as set forth in example 4 on page 246.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitts et al., Journal of the American Chemical Society. Fitts teaches the compounds of formula (I) where R^1 , $R^{1'}$, R^2 , $R^{2'}$, R^3 , $R^{3'}$, R^4 , $R^{4'}$, R^5 , $R^{5'}$, R^6 , and $R^{6'}$ are hydrogen; X is I^- and R^7 and R^8 are each $-CH_2-CH=CH_2$ as set forth in example XV on page 485.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Beilstein Registry Number 4927823 (XP-002532004). Beilstein Reg. No. 4927823 teaches the compounds of formula (I) where R^1 , $R^{1'}$, R^2 , $R^{2'}$, R^3 , $R^{3'}$, R^4 , $R^{4'}$, R^5 , $R^{5'}$, R^6 , and $R^{6'}$ are hydrogen; X is Br^- and R^7 and R^8 are each $-CH_2-CH=CH_2$.

Claim Objections

10. Claims 4 and 12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must stated in the alternative. See MPEP § 608.01(n).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624